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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,671	01/21/2004	Loretta E. Allen	84196CF-9	3403

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EXAMINER	
HENDERSON, MARK T	

ART UNIT	PAPER NUMBER
3722	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/761,671	ALLEN ET AL.
	Examiner	Art Unit
	Mark T Henderson	3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is finally rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al (5,575,507).

Yamauchi et al discloses in Fig. 2-4 a media comprising an image-receiving layer (8) on which a first image indicia (2) is formed; a protective overlayer (4) provided over the image-receiving layer (8), wherein the protective overlayer has a second image indicia (5) formed thereon that is machine readable (Col. 4, lines 20-23).

In regards to **Claim 1**, the method of forming machine-readable indicia during application of the protective overlayer over the image receiving layer does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it is inherent to form the machine-readable indicia during any application process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 2, 3, 4, 6 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al.

Yamauchi et al discloses a media and further a label comprising all the elements as claimed in Claim 1 and as set forth above. Yamauchi et al further discloses wherein the indicia is transparent so as to allow viewing of the image, and comprises an IR absorbing dye (Col. 4, lines 5-26).

However, Yamauchi et al does not disclose: wherein the image is formed using a thermal head; and wherein first indicia is machine readable; and the second indicia is identical in content to, and in register with the first indicia in the image layer.

In regards to **Claims 2 and 7**, the method of using a thermal head to form an image; and the method of forming machine-readable indicia during application of the protective overlayer over the image receiving layer does not structurally limit the claim; and . The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious: to use any device to form the image on the image-receiving layer; and form the machine-readable indicia during any application process.

In regards to **Claim 6**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any type of indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the protective layer, since applicant has not disclosed the criticality of having a particular indicia, and invention would function equally as well with any type of indicia.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to place the second indicia at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Therefore, it would have been obvious to place the indicia at any location, since applicant has not disclosed the criticality of the indicia being at a particular location, and invention would function equally as well if the second indicia is placed at any desirable location on the protective overlayer.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al in view of Waldhoff (5,316,343).

Yamauchi et al discloses a media and further a label comprising all the elements as claimed in Claim 1 and as set forth above. However, Yamauchi et al does not disclose a media substrate comprising an adhesive layer for securing to an item.

Waldhoff discloses in Fig. 2 and 3, a media (16) having a substrate with a protective layer (32) and an adhesive layer (24).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yamauchi et al's media with an adhesive layer as taught by Waldhoff for the purpose of securing the substrate to an item.

Response to Arguments

4. Applicant's arguments filed on June 28, 2004 have been fully considered but they are not persuasive.

In regards to applicant's argument that the prior art of record does not disclose "that the forming of machine-readable indicia occurs during application of the protective overlayer", the examiner submits that the method of forming machine-readable indicia during application of the protective overlayer over the image receiving layer does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior art was made by a different process (see MPEP 2113). The Patent Office is not equipped to search the myriad of process put before it to manufacture products and make physical comparisons therewith. *In re Brown*, 459 F.2d 531, 535. The limitations added by applicant are not functional limitations as asserted. The added limitations do not set forth a particular function of a recited element. They do, however, set forth a process of manufacture step.

Therefore, the examiner's rejection has been maintained.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

October 16, 2004

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700